



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,053	12/09/2003	Kenichiro Aridome	246314US6	2956
22850	7590	03/18/2008		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER ZHAO, DAQUAN	
			ART UNIT 2621	PAPER NUMBER
			NOTIFICATION DATE 03/18/2008	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com

oblonpat@oblon.com

jgardner@oblon.com

Office Action Summary

Application No.

10/730,053

Applicant(s)

ARIDOME, KENICHIRO

Examiner

DAQUAN ZHAO

Art Unit

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-9,11-15,17-27,29 and 30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-9,11-15,17-27,29-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 11/26/2007;12/21/2007
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-3, 5-9, 11-15, 17-27, 29-30 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 13-15, 17-18 are rejected under 35 U.S.C. 101 because claim 13 is directed to non statutory subject matter.

Claim 13 recites "a recording medium which records inputted image data...", wherein the image data is considered to be nonfunctional descriptive material. When nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because "[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer."). Such a result would exalt form over substance. In re *Sarkar*, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978) ("[E]ach invention must be

Art Unit: 2621

evaluated as claimed; yet semantogenic considerations preclude a determination based solely on words appearing in the claims. In the final analysis under § 101, the claimed invention, as a whole, must be evaluated for what it is.”) (quoted with approval in *Abele*, 684 F.2d at 907, 214 USPQ at 687). See also *In re Johnson*, 589 F.2d 1070, 1077, 200 USPQ199, 206 (CCPA 1978) (“form of the claim is often an exercise in drafting”). Thus, nonstatutory music is not a computer component, and it does not become statutory by merely recording it on a compact disk. Protection for this type of work is provided under the copyright law.

Claims 14-15, 17-18 are also affected.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 2, 3, 5, 6, 7, 8, 9, 11, 12, 13, 14, 15, 17, 18, 25, 26, 27, 29 and 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Fuller et al (US 6,833,865 B1)

Art Unit: 2621

and further in reference of "Wikipedai, the free encyclopedia, F-number" (google key words "f stop", a copy of this reference is provided).

For claim 1, Fuller et al teach a method of compressing and recording data of image information on a recording medium according to a decoding and reproducing unit comprising a plurality of frames (e.g. column 7, lines 31-50, the phrase "a decoding and reproducing unit comprising a plurality of frames" corresponds to "video frames"), a method comprising:

performing compression of inputted image data (e.g. column 7, lines 31-50, MPEG or motion JPEG);

generating additional information about the inputted image data (e.g. column 5, lines 42-57, metadata corresponds to "additional information" as claimed); and

multiplexing an additional information block that includes the additional information generated in the generating step at a block position immediately before or after a group of blocks that includes compressed image information processed by compression encoding through the use of only image information in the decoding and reproducing unit, and recording the additional information block on the recording medium (e.g. column 5, line 65- column 6, line 36, Metadata is formatted into packets, and multiplexed with the video and audio packets, and metadata packet is placed along side the digital video and audio packets),

wherein the additional information includes capturing condition values, which includes at least diaphragm adjustment and exposure values (e.g. column 5, lines 43-53, metadata includes exposure values and f-stop. "diaphragm adjustment" is the

Art Unit: 2621

aperture stop, which is also called f stop described in page 2, under the "Stops, f-stop conventions, and exposure" in "Wikipedai, the free encyclopedia, F-number").

Claims 7, 13, and 25 are rejected for the same reasons as discussed in claim 1 above.

For claims 2, 8, 14 and 26, Fuller et al teach the additional information comprises one or more of the blocks (e.g. column 6, line 6-9).

For claims 3, 9, 15, and 27, Fuller et al teach the additional information block is multiplexed at a predetermined block position and is recorded on the recording medium (e.g. column 6, lines 19-36).

For claims 5, 11, 17 and 29, Fuller et al teach the additional information includes at least information about a time to obtain the image information (e.g. column 5, lines 42-64, tim/date or time stamp).

For claims 6, 12, 18, and 30, Fullet et al teach the additional information includes information about the condition of obtaining the image information (e.g. column 5, lines 42-52, lens properties).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 19-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fuller et al (US 6,833,865 B1) and in reference of "Wikipedai, the free encyclopedia, F-

Art Unit: 2621

number" (google key words "f stop", a copy of this reference is provided), as applied to claims 1, 2, 3, 5,6, 7, 8, 9, 11, 12, 13, 14, 15, 17, 18, 25, 26, 27,29 and 30 above, and further in view of in view of Kikuchi et al (US 2002/0,041,754 A1).

See the teaching of Fuller et al above.

For claim 19, Fuller et al fails to teach reading compressed image information according to the decoding and reproducing unit from the recording medium, decompressing the compressed image information, and reproducibly outputting image information according to the decoding and reproducing unit; and extracting the additional information contained in the read/write unit and reproducibly outputting the additional information in synchronization with reproduction output of the image information according to the decoding and reproducing unit contained in the corresponding read/write unit

Kikuchi et al teach reading compressed image information according to the decoding and reproducing unit from the recording medium, decompressing the compressed image information, and reproducibly outputting image information according to the decoding and reproducing unit (e.g. paragraph [0072] teach the data are encoded in MPEG compression format, and the data must be decoded in MPEG decompression format); and extracting the additional information contained in the decoding and reproducing unit and reproducibly outputting the additional information in synchronization with reproduction output of the image information according to the decoding and reproducing unit (e.g. [0097]-[0098], the decoder which is user for reproduction, wherein the operation of the decoder is in synchronization with the

Art Unit: 2621

System Time Clock (TSC), packs in figure 3, which include the RDI pack, V pack and A pack and SP pack, are extracted by the decoder in synchronism with the STC). It would have been to one ordinary skill in the art at the time the invention was made to incorporate the teaching of Kikuchi et al into the teaching of Fuller et al for generating metadata descriptions that can be effectively used to index the content for downstream applications such as searching.

Claim 20 is rejected for the same reasons as discussed in claim 19 above, wherein paragraph [0083] teach data in the VOB in figure 3, which contains the V pack is reproduced in accordance with the time code specify in the RDI pack, which corresponds to "using the reproduced additional information to control image information according to the decoding and reproducing unit (VOB) contained in the corresponding read/write unit.

Claims 21 and 24 are rejected for the same reasons as discussed in claim 20 above, wherein figure 1 discloses the key input section, which contains play, stop, REC, and TS...etc commands, and user can use these command to control the system in figure 1 to "reproducibly outputting the encoded image information in the decoding and reproducing unit repeatedly for the number of decoding and reproducing units fewer than the number of decoding and reproducing units contained in the read/write unit" because user can stop playing the decoder when the reproducing data from the read/write unit before all the data in the read/write unit is reproduced.

Claims 22 and 23 are rejected for the same reasons as discussed in claim 22 above.

Art Unit: 2621

Applicant's amendment necessitated the new ground(s) of rejection presented in this office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07 (a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136 (a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period. Then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daquan Zhao whose telephone number is (571) 270-1119. The examiner can normally be reached on M-Fri. 7:30 -5, alt Fri. off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tran Thai Q, can be reached on (571)272-7382. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Daquan Zhao/
Examiner, Art Unit 2621
Daquan Zhao

/Thai Tran/
Supervisory Patent Examiner, Art Unit
2621